

REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-20 are pending in the subject application.

Claims 1-20 stand rejected under 35 U.S.C. §102, 35 U.S.C. §103, and/or 35 U.S.C. §112, first paragraph. Claims 13-18 were objected to because of identified informalities.

Claim 1 was amended for clarity and so as to thereby also address the Examiner's non-art based rejections.

The amendments to the claims are supported by the originally filed disclosure.

The Title of the invention was objected to and correction required. Applicants do not believe that an amendment to the Title is required as discussed further herein.

The drawing figures were objected to and correction required. As indicated herein, Applicants believe that the drawing figures show the required information as discussed herein.

35 U.S.C. §112, FIRST PARAGRAPH REJECTIONS

Claims 1, 3, 5, 7, 9, 11, 13, 15, 17, 19/1, 19/5, 10/13 and 20/15 stand rejected under 35 U.S.C. §112 because the subject application fails to provide a written description of what has been referred to as the "ultimate" wherein clause in the Office Action. Applicants respectfully traverse.

As indicated above, claim 1 was amended for clarity and so as to thereby also address the Examiner's non-art based rejections. Therefore, Applicants believe that the within rejection has been overcome and thus, request that the rejection under §112, first paragraph be withdrawn.

Accordingly, claims 1, 3, 5, 7, 9, 11, 13, 15, 17, 19/1, 19/5, 10/13 and 20/15 satisfy the requirements of 35 U.S.C. §112, first paragraph and, therefore, these claims are allowable.

OBVIOUSNESS DOUBLE PATENTING REJECTION

Claims 1-20 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1, 3 and 7 of U.S. Patent No. 6,288,992 ("the '992 patent"). It is further asserted in the Office Action that while the conflicting claims are not identical that are not patentably distinct from each other. Applicants respectfully traverse.

Applicants would respectfully submit that none of the identified claims of the '992 patent discloses, teaches or suggests a predetermined length mark signal measurement means for measuring reproduction signal characteristics respectively of a short reproducing power control mark and of a long reproducing power control mark from information data that is recorded throughout a data recording area of a sector of an optical recording medium. In particular, the identified claims of the '992 patent do not disclose, teach or suggest a predetermined length mark signal measurement means that is further operable to detect a specific pattern including therein an arrangement of a plurality of short reproducing power control marks from amongst a bit arrangement pattern of the information data in the data recording area, and when the specific

pattern is detected, to measure the reproduction signal characteristic of short reproducing power control marks, the measured reproduction signal characteristic of short reproducing power control marks corresponding only to the plurality of short reproducing power control marks included in the specific pattern. Further, the identified claims of the '992 patent do not provide any teaching motivation or suggestion to modify the invention of the identified claims so as to produce the invention as set forth in claim 1. Moreover, the Office Action fails to identify another document that provides such a teaching, suggestion or motivation to one skilled in the art to so modify the claims of the '992 patent and also fails to provide a detailed basis why one skilled in the art would have been motivated to amend the invention of the identified claims of the '992 patent.

Also, claim 2 includes a comparison means for comparing a bit arrangement pattern of the information data reproduced by the data reproduction means with a specific pattern including an arrangement of a plurality of short reproducing power control marks, and for detecting a coincidence of the specific pattern of the plurality of short reproducing marks in the bit arrangement pattern of the information data and a signal measurement means for measuring the reproduction signal characteristic of information data bits corresponding to the plurality of short reproducing power control marks, when the comparison means detects the bit arrangement pattern of the information data coincides with the specific pattern including the plurality of short reproducing power control marks. No such features are disclosed, taught or suggested in the identified claims of the '992 patent that is sufficient to provide an enabling disclosure. In

addition, the identified claims of the 1992 patent do not provide any teaching motivation or suggestion to modify the invention of the identified claims so as to produce the invention as set forth in claim 2. Further, the Office Action also fails to identify another document that provides such a teaching, suggestion or motivation to one skilled in the art to so modify the claims of the '992 patent and also fails to provide a detailed basis why one skilled in the art would have been motivated to amend the invention of the claims of the '992.

Therefore, Applicants respectfully submit that in view of the foregoing remarks, the rejection has been overcome and the above identified claims are allowable.

35 U.S.C. §103 REJECTIONS

Claims 1-18 stand rejected under 35 U.S.C. §103 as being unpatentable over Applicants Admitted Prior Art (AAPA) in view of Tanaka et al. and all further considered in view of Okumura et al. [USP 6,288,992; "Okumura '992"]. Applicants respectfully traverse as discussed below. Because claim 1 was amended in the foregoing amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

As indicated above, Applicants amended claim 1 so as to more clearly provide that the power control marks are from the information data recorded through out the data recording area. Claim 1 also was amended so as to clarify that measuring only to the plurality of short

reproducing power control marks included in the specific pattern relates to measuring short reproducing control marks and thus did not exclude the measurement of the long reproducing power control marks. It is respectfully submitted none of the three cited references taken alone or in combination teach the features of claim 1, in particular the measurement means of claim 1.

Also and as indicated previously, Tanaka merely teaches a specific test pattern, however, it is clear from the discussion in Tanaka that the results of the test are not used in any way to setting of a power value. Therefore, there is no teaching, suggestion, or motivation, to combine the references in the fashion suggested in the Office Action so as to yield the claimed invention.

As to claim 2; as indicated in the discussion above regarding the obviousness double patenting rejection claim 2 includes a comparison means for comparing a bit arrangement pattern of the information data reproduced by the data reproduction means with a specific pattern including an arrangement of a plurality of short reproducing power control marks, and for detecting a coincidence of the specific pattern of the plurality of short reproducing marks in the bit arrangement pattern of the information data and a signal measurement means for measuring the reproduction signal characteristic of information data bits corresponding to the plurality of short reproducing power control marks, when the comparison means detects the bit arrangement pattern of the information data coincides with the specific pattern including the plurality of short reproducing power control marks. The three cited references, alone or in combination, include no teaching or suggestion to modify the disclosures of the primary reference so as to yield the claimed invention.

Claims 3-18 each depend directly or ultimately from one of claims 1 or 2. As such, each of claims 3-18 are considered to be allowable at least because of the dependency from an allowed base claim. This shall not be construed, however, as an admission that claims 3-18 are not separately patentable from the cited art.

The following additional remarks shall apply to each of the above.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, “The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the foregoing remarks that the above identified claims are not anticipated by the prior art and AAPA.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the cited references and AAPA, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited references and AAPA, there is no reasonable expectation of success provided in the references. Also, it is clear from the foregoing discussion that the modification suggested by the Examiner would change the principle of operation of the disclosed device.

As the USPTO Board of Patent Appeals and Interferences has held, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ351, 353 (BD. Pat. App. & Inter. 1984). It is clear from the foregoing remarks, however, that the suggested modification to the device disclosed in the cited art would

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require a modification to the operation of the disclosed device and/or is more than an obvious matter of design choice.

It is respectfully submitted that for the foregoing reasons, claims 1-18 are patentable over the cited reference(s) and AAPA, and therefore satisfy the requirements of 35 U.S.C. §103.

Thus, these claims are allowable.

CLAIM OBJECTIONS

Claims 13-18 were objected to as being in improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully traverses.

It appears that the objection is based on the language of claim 1. Claims 14, 16 and 18, however, depend directly or ultimately from claim 2. As there is no language in claim 2 that corresponds to the language set forth in the grounds for objection, Applicants respectfully submit that the objection as to claims 14, 16 and 18 is not proper.

Applicants believe that the clarifying amendment to claim 1 is such that the objection as to claims 13, 15 and 17 is overcome.

In view of the foregoing remarks, claims 13-18 are considered to be acceptable.

SPECIFICATION OBJECTIONS

The Examiner objected to the as-amended TITLE as not being descriptive of the invention being claimed and requested correction.

In general, the title of the invention should be sufficient to describe the invention to which the claims are directed. In this regard, Applicants would note that the claimed invention is directed to an optical reproducing device which is what is being claimed by Applicants. When the preamble of claims 1 and 2 was amended to address the previous objection to the Title, Applicants further provided that the invention is directed to an “OPTICAL REPRODUCING DEVICE THAT CONTROLS THE STRENGTH OF THE LIGHT BEAM DURING REPRODUCTION” which also describes the claimed invention.

As provided in MPEP 600, the title should be brief but technically accurate and descriptive and should contain fewer than 500 characters. The MPEP also indicates that while a longer title may result in a loss in brevity, the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching. In the present circumstances, Applicants believe that the amended title is brief, technically accurate and descriptive of the invention to which the claims are directed to and thus, satisfies the applicable rule criterion as further set forth in the MPEP.

In view of the foregoing, Applicants do not believe that further amendment is required of the Title. Also, Applicants would note that the amended Title would appear to have been

previously accepted by the Examiner in a prior Office Action and thus there is no explanation why the earlier accepted Title is not considered acceptable.

It is respectfully submitted that for the foregoing reasons, the specification including the TITLE satisfies applicable Patent laws and rules and, therefore is considered acceptable.

DRAWING OBJECTIONS

The Examiner objected to the drawing figures for the reasons provided on page 1 of the above-referenced Office Action. Applicants respectfully submit that the drawing figures present the allegedly missing information.

The predetermined length mark signal measurement means is shown in the drawing figures, with particular reference to elements 6-9 of Figure 1. As to the throughout a data recording area language in the claim, Figure 2 illustrates a data recording area and Figure 4 illustrates the contents of the data recording area (giving an example of short reproducing power control marks recorded through out the data recording area).

In view of the foregoing remarks, do not believe that further amendment of the identified drawing figures is necessary. As such the drawing figures are considered acceptable and further correction is not required.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

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Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
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